AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/491,703
Filing Date: January 26, 2000
Title: METHOD AND APPARATUS FOR FACILITATING USER SELECTION OF A CATEGORY ITEM IN A TRANSACTION

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REMARKS

This responds to the Office Action mailed on <u>March 26, 2008</u>.

No claims are amended, no claims are canceled, and no claims are added; as a result

claims 9, 11-16, 25, 27-32, 41, 43-48, 58-59, 62-63, 66-67, 71, 73, and 75 remain pending in this

application.

§103 Rejection of the Claims

Claims 9, 11-15, 25 and 41-47 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Greef et al. (U.S. Patent No. 6,397,221, hereinafter; "Greef").

For the reasons set forth below, Applicant respectfully submits that the rejection is moot

and the identified claims are non-obvious over Greef and are therefore allowable. Rejections on

obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.[1]

Claim 9 recites, in pertinent part:

> "responding to said detection of said selection of said category entry,
> providing a plurality of subcategory entries . . . <u>to be hierarchically
> displayed for said user in at least one subcategory field within said display
> window</u>, . . . <u>said plurality of subcategory entries being used to categorize
> said item in said transaction</u>."

The Final Office Action, at page 3, alleges that this limitation is disclosed by Greef at col.

7, lines 31-44, col. 29, line 40 – col. 30, line 60, and col. 31, lines 18-59. Applicant respectfully

disagrees with the allegation. Greef in the cited passages merely discusses preparation of a

category register that lists the product categories and subcategories and creating category and

product frames:

> "As shown in FIG. 20, the second form of the method . . . includes a step .
> . . at which the program <u>prompts the user for identification of the tabular
> data</u> to be incorporated into frame-based hierarchical form. . . . In
> response, <u>the user would identify the source of tabular data</u> of table 400 in

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[1] *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)

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conventional fashion; e.g. <u>by designating a file name and path for locating the file</u>. . . . the method reviews the tabular data of table 400 and extracts information <u>for building a series of registers</u> that are subsequently used in formulating the frame-based, hierarchical structure for the data. Particularly, <u>the method prepares a Category register that lists the product categories and subcategories for the data</u> . . . In addition to creating a categories register, the method at step 506 also <u>creates a Products register which list the products</u> of the respective rows of table 400, using a suitable identifying attribute; e.g., Model Name, the attribute value identifying the respective products." [2]

"Following analysis of the tabular data and generation of the respective data registries . . . the program advances to <u>Create Category and Product Frames</u> step 506 at which the program embodying the method begins development of the frame-based hierarchical structure to accommodate the table 400 product data. . . . Additionally, the program at step 506 <u>also establishes a subordinate level 438 beneath category frame 436, for subcategory frames</u> . . . Following, generation of an initial form of hierarchical structure 434 at step 506, processing advances to Create "IS A" Relationship step 508 at which the program continues development of structure 434 by identifying the respective hierarchical associations for the table 400 products relative to the category-subcategory structure. To accomplish this the program refers to the Relationships register, and identifies the associations included there." [3]

According to the first cited passage, the program prompts the user for identification of a tabular data and the user would identify the source of tabular data by designating a file name and path for locating the file. The method reviews the tabular data and extract information for building a series of registers. The second cited passage states that the program advances to create category and product frames setup.

However, none of the steps described in the passages amounts to *responding to said detection of said selection of said category entry, providing a plurality of subcategory entries and displaying for said user in at least one subcategory field within said display window, . . . said plurality of subcategory entries being used to categorize said item in said transaction,* as recited in claim 9. Accordingly, Greef does not disclose the limitation of *"responding to said detection of said selection of said category entry, providing a plurality of subcategory entries . . .*

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[2] Greef, col. 29, line 40 – col. 30, line 60
[3] Greef, col. 31, lines 18-59

to be hierarchically displayed for said user in at least one subcategory field within said display window, . . . said plurality of subcategory entries being used to categorize said item in said transaction," as recited in claim 9. The Office Action further asserts, "Greef did not expressly disclose a transaction, since this is an e-commerce shopping system and method, a transaction is obviously present." Applicant respectfully disagrees with the assertion and submits that Greef is a system and method "for creating and or modifying the organizational structure and data content of a frame-based, hierarchical product database with the use of tabularly arranged product data." (Abstract)

Furthermore, in rejecting claim 9, when discussing the claim limitation of "providing a category number associated with said selected category entry to be displayed for said user in said display window," the Office Action relies on Greef's Abstract, and portions of the above cited passages. Applicant respectfully submits that neither the abstract nor any of the cited passages provides *category number to be displayed for user in display window.* Accordingly, the claim 9 limitation of "*providing a category number associated with said selected category entry to be displayed for said user in said display window*" is not described or shown in Greef.

As such, Greef fails to teach or suggest each and every element of claim 9. Therefore, Applicant respectfully submits that there are substantial differences between what is claimed and what the Office Action contends to be shown in Greef. Because the Greef does not show all of the elements of the claimed subject matter of claim 1, those differences are significant and non-obvious to a person of ordinary skill in the art at the time the application was filed. Thus, claim 9 and its dependent claims 11-15 are not rendered obvious by Greef and are allowable.

The same arguments as presented with respect to claim 9 are also applicable to a consideration of independent claims 25 and 41. As such, at least for the reasons discussed above with respect to claim 9, claims 25 and 41 and dependent claims 43-47 are not rendered obvious by Greef and are, thus, allowable.

Claims 16, 32, 48, 58-59, 62-63, 66-67, 71, 73 and 75 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Greef in view of Linden et al. (U.S. Publication No. 2005/0071581A1, hereinafter; "Linden").

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Claims 16, 32, 48, 58-59, 62-63, 66-67, 71, 73 and 75 are dependent on independent claims 9, 25, and 41. Thus, they are deemed to include every limitation of the claims they are dependent upon. The difference between claims 9, 25, and 41 and the disclosure in Greef is not remedied by the disclosure of Linden. Thus, Applicant respectfully submits that, at least for the reasons noted above, the obviousness rejection of claims 9, 25, and 41 over the combination of Greef and Linden is in error. As such, at least for the same reasons articulated above with respect to the independent claims 9, 25, and 41, dependent claims 16, 32, 48, 58-59, 62-63, 66-67, 71, 73 and 75 are not rendered obvious by Greef. Therefore, these claims are also allowable.

Applicant respectfully requests that the claim rejections under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at 408-278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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